UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,155	08/22/2000	Shigeru Kakugawa	1141/61930	7636

7590 05/22/2003

Ivan S Kavrukov
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER
BARRERA, RAMON M

ART UNIT	PAPER NUMBER
2832	

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/554,155	KAKUGAWA, ET AL.	
	Examiner	Art Unit	
	Ramon M Barrera	2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above claim(s) *See Continuation Sheet* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,17,19,20,31,43,49,55,61,63 and 64* is/are rejected.

7)☒ Claim(s) *7,9-16 and 37* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 August 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2-6,8,18,21-30,32-36,38-42,44-48,50-54,56-60,62 and 65.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 12 is acknowledged. The traversal is on the ground(s) that all of the inventions are sufficiently related to be examined in one application. This is not found persuasive because the claims relate to a multiplicity of species where an unduly extensive and burdensome search is required. Furthermore, since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2-6, 8, 18, 21-30, 32-36, 38-42, 44-48, 50-54, 56-60, 62, and 65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing. More specifically, JP9-329857 is missing.

Specification

4. The abstract of the disclosure is objected to because it includes legal phraseology, i.e., "means". Correction is required. See MPEP § 608.01(b).

Double Patenting

5. Applicant is advised that should claim 19 be found allowable, claim 63 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

6. Claims 9-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 9-16 not been further treated on the merits.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 49, 55, 61, and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the acronym "MCI" which is not understood.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1, 19, 43, 49, and 63 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dorri(#168) in Fig. 2 (note Examiner markings).

11. Claims 1, 19, 43, 49, and 63 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dorri(#523) in Fig. 1 (note Examiner markings).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 17, 20, 55, 61, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorri #168.

Dorri is silent regarding the operating orientation of his MRI device in Fig.2. It was commonly known to those of ordinary skill in the art that a vertical orientation for the MRI device depicted in Fig. 2, and consequent insertion of a patient between assemblies 44 and 46, provided increased access to the patient by medical personnel as well as reduced feelings of patient claustrophobia. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to operate Dorri's magnet in a vertical orientation for the purpose recognized in the art of Dorri, as discussed above.

14. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorri#523 in view of Ono, et al..

Dorri#523 does not disclose an external ferromagnetic body for suppressing leakage magnetic flux. Ono discloses an external ferromagnetic body 1 for the purpose of suppressing leakage magnetic flux. Since Dorri and Ono are both from the same field of endeavor, the purpose disclosed by Ono would have been recognized in the pertinent art of Dorri. It would have been obvious at the time the invention was made to

a person having ordinary skill in the art to employ an external ferromagnetic body 1 for the purpose of suppressing leakage magnetic flux.

Allowable Subject Matter

15. Claims 7-1 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramon M Barrera whose telephone number is (703)308-0636. The examiner can normally be reached on Monday through Friday from 3 to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (703)308-7619. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7724 for regular communications and (703)305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1782.

Ramon M Barrera
Primary Examiner
Art Unit 2832

rmb
May 18, 2003